UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,710	08/28/2001	Yoichiro Sako	7217/65200	5743

7590 04/07/2005	EXAMINER
COOPER & DUNHAM LLP	ABRISHAMKAR, KAVEH

COOPER & DUNHAM LLP
1185 Avenue of the Americas
New York, NY 10036

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 August 2001</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-95</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-95</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s) .

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>10/27/2003</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the communication filed on August 28, 2001.

Claims 1 – 95 were originally received for consideration. The preliminary amendment

received on October 28, 2003 amended claims 1-95, and the amended versions of the

claims are now being considered.

Information Disclosure Statement

2.   An initialed and dated copy of the Applicant's IDS form 1499, received on

October 27, 2003, is attached to this Office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-95 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuroda

et al. (U.S. Patent No. 6,707,774).

Regarding claim 1, Kuroda discloses:

A method for outputting data read from a recording medium, comprising the steps of:

decoding the data read from the recording medium (column 2 lines 47-53);

embedding electronic watermark information in the decoded data when the decoded data is output as recording data (column 7 lines 36-45).

Claim 2 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

The method according to claim 1, further comprising the steps of determining a type of the recording medium and changing said electronic watermark information based on the type of recording medium (column 7 line 64 – column 8 line 13).

Claim 3 is rejected as applied above in rejecting claim 2. Furthermore, Kuroda discloses:

The method according to claim 2, further comprising the step of embedding electronic watermark information indicating at least a first generation recording is allowed when the recording medium is a read-only recording medium (column 7 lines 5-20).

Claim 4 is rejected as applied above in rejecting claim 3. Furthermore, Kuroda discloses:

The method according to claim 3, further comprising the step of embedding

electronic watermark information indicating recording is prohibited when the recording

medium is a recordable recording medium (column 7 lines 5 – 20).

Claim 5 is rejected as applied above in rejecting claim 2. Furthermore, Kuroda

discloses:

The method according to claim 2, further comprising the step of embedding

electronic watermark information indicating the data read from the recording medium

when the recording medium is a read-only recording medium (column 19 lines 30-35).

Claim 6 is rejected as applied above in rejecting claim 5. Furthermore, Kuroda

discloses:

The method according to claim 5, further comprising the step of embedding

electronic watermark information indicating the data is copied data when the recording

medium is a recordable recording medium (column 19 lines 30-35).

Claim 7 is rejected as applied above in rejecting claim 2. Furthermore, Kuroda

discloses:

The method according to claim 2, wherein the type of recording medium is

determined by determining whether a pit wobbling portion is present on the recording

medium (column 3 line 58 – column 4 line 3).

Claim 8 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

The method according to claim 1, further comprising the step of not embedding said electronic watermark information in the decoded data when the decoded data is output as playback data (column 6 lines 13 – 28).

Claim 9 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda discloses:

The method according to claim 1, further comprising the step of embedding electronic watermark information for analog data in the decoded data when the decoded data is output in an analog format (column 7 lines 37 – 54).

Claim 10 is rejected as applied above in rejecting claim 9. Furthermore, Kuroda discloses:

The method according to claim 9, wherein the decoded data is converted into an analog signal, and the electronic watermark information for analog data is embedded in the analog signal (column 7 lines 37–54).

Claim 11 is rejected as applied above in rejecting claim 9. Furthermore, Kuroda discloses:

The method according to claim 9, further comprising the step of determining the type of recording medium and changing the electronic watermark information for analog data based on the type of recording medium (column 7 line 64 – column 8 line 13).

Claim 12 is rejected as applied above in rejecting claim 11. Furthermore, Kuroda discloses:

The method according to claim 11, further comprising the step of embedding electronic watermark information including at least first generation recording is allowed when the recording medium is a read-only recording medium (column 7 lines 5-20).

Claim 13 is rejected as applied above in rejecting claim 12. Furthermore, Kuroda discloses:

The method according to claim 12, further comprising the step of embedding electronic watermark information indicating recording is prohibited when the recording medium is a recordable recording medium (column 7 lines 5 – 20).

Claim 14 is rejected as applied above in rejecting claim 11. Furthermore, Kuroda discloses:

The method according to claim 11, further comprising the step of embedding electronic watermark information indicating the data read from the recording medium when the recording medium is a read-only recording medium (column 19 lines 30-35).

Claim 15 is rejected as applied above in rejecting claim 14. Furthermore, Kuroda

discloses:

The method according to claim 14, further comprising the step of embedding

electronic watermark information indicating the data is copied data when the recording

medium is a recordable recording medium (column 19 lines 30-35).

Claim 16 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda

discloses:

The method according to claim 1, further comprising the step of embedding

electronic watermark information for digital data when the decoded data is output in a

digital format as the recording data (column 7 lines 37 – 54).

Claim 17 is rejected as applied above in rejecting claim 16. Furthermore, Kuroda

discloses:

The method according to claim 16, further comprising the steps of determining a

type of the recording medium and changing the electronic watermark information for

digital data based on the type of recording medium (column 7 line 64 – column 8 line

13).

Claim 18 is rejected as applied above in rejecting claim 17. Furthermore, Kuroda

discloses:

The method according to claim 17, further comprising the step of embedding electronic watermark information indicating at least first generation recording is allowed when the recording medium is a read-only recording medium (column 7 lines 5-20).

Claim 19 is rejected as applied above in rejecting claim 18. Furthermore, Kuroda discloses:

The method according to claim 18, further comprising the step of embedding electronic watermark information indicating recording is prohibited when the recording medium is a recordable recording medium (column 7 lines 5 – 20).

Claim 20 is rejected as applied above in rejecting claim 17. Furthermore, Kuroda discloses:

The method according to claim 17, further comprising the step of embedding electronic watermark information indicating the data read from the recording medium when the recording medium is a read-only recording medium (column 19 lines 30-35).

Claim 21 is rejected as applied above in rejecting claim 20. Furthermore, Kuroda discloses:

The method according to claim 20, further comprising the step of embedding electronic watermark information including the data is copied data when the recording medium is a recordable recording medium (column 19 lines 30-35).

Claim 22 is rejected as applied above in rejecting claim 1. Furthermore, Kuroda

discloses:

The method according to claim 1, further comprising the step of not embedding

said electronic watermark information in the decoded data when an operating key is

operated to give a playback command to execute a play back operation in an apparatus

that has located thereon the recording medium (column 6 lines 13 – 28).

Claim 23 is rejected as applied above in rejecting claim 22. Furthermore, Kuroda

discloses:

The method according to claim 22, further comprising the step of embedding said

electronic watermark information in the decoded data when an operating key is

operated to give a recording command to execute a recording operation in an apparatus

that has loaded thereon the recording medium (column 7 lines 36-45).

Regarding claim 24, Kuroda discloses:

A data recording method comprising the steps of:

determining whether electronic watermark information is detected from received

data (column 7 lines 5-63);

when the electronic watermark information is detected, executing a recording

operation of the received data according to the detected electronic watermark

information (column 7 lines 5-63); and

when the electronic watermark information is not detected, canceling the

recording operation of the received data (column 8 lines 13 – 33).

Claims 25 – 34 claim analogous subject matter to the method claims 1-23 rejected

above, and therefore, are rejected following the same reasoning applied above.

Regarding claim 35, Kuroda discloses:

A method for outputting data read from a recording medium, comprising the

steps of:

detecting copy management information from the data read from the recording

medium (column 7 line 64 – column 8 line 13);

determining the detected copy management information (column 7 line 64 –

column 8 line 13); and

embedding electronic watermark information in the data read from the recording

medium according to the determined copy management information when the data read

from the recording medium is output as recording data (column 7 line 64 – column 8 line

13).

Claims 36 – 41 claim analogous subject matter to the method claims 1-23 rejected

above, and therefore, are rejected following the same reasoning applied above.

Regarding claim 42, Kuroda discloses:

A data output method comprising the steps of:

determining a type of destination device to which data is output (column 9 line 33

– column 10 line 48);

determining whether the destination device is capable of transmitting and

receiving the data in a secure state (column 9 line 33 – column 10 line 48);

determining whether the destination device is a recording apparatus when it is

determined that the destination device is capable of transmitting and receiving the data

in a secure state (column 9 line 33 – column 10 line 48);

determining copy management information attached to the data when it is

determined that the destination device is a recording apparatus (column 7 line 64 –

column 8 line 13); and

embedding electronic watermark information in the data according to the

determined copy management information (column 7 line 64 – column 8 line 13).

Claims 43-47 claim analogous subject matter to the method claims 1-23 rejected above,

and therefore, are rejected following the same reasoning applied above.

Regarding claim 48, Kuroda discloses:

An apparatus for playing back a recording medium, comprising:

a head for reading data from the recording medium (column 7 line 64 – column 8

line 13);

a decoder for decoding an output signal from said head (column 7 line 64 –

column 8 line 13); and

an adding unit for embedding electronic watermark information in the data from

said decoder when the data from said decoder is output as recording data (column 7

line 64 – column 8 line 13).

Claims 49-67 claim analogous subject matter to the method claims 1-23 rejected above,

and therefore, are rejected following the same reasoning applied above.

Regarding claim 68, Kuroda discloses:

A data recording apparatus comprising:

a detector for detecting electronic watermark information from received data

(column 7 lines 5-63);

an encoder for encoding the received data (column 7 lines 5-63); and

a controller for allowing the detected electronic watermark information from said

detector to be decoded and for controlling a recording of the data from said encoder

according to the decoded electronic watermark information (column 7 line 37 – column

8 line 13).

Claims 69- 79 claim analogous subject matter to the method claims 1-23 rejected

above, and therefore, are rejected following the same reasoning applied above.

Regarding claim 80, Kuroda discloses:

An apparatus for playing back a recording medium, comprising:

a head for reading data from the recording medium (column 7 line 64 – column 8

line 13);

a detector for detecting copy management information from an output signal from

said head medium (column 7 line 64 – column 8 line 13); and

an adding unit for adding electronic watermark information according to the

detected copy management information to the data read from the recording medium

when the data read from the recording medium is output as recording data (column 7

line 64 – column 8 line 13).

Claims 81 – 95 claim analogous subject matter to the method claims 1-23 rejected

above, and therefore, are rejected following the same reasoning applied above.

Conclusion

4.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaveh Abrishamkar whose telephone number is 571-272-3786. The examiner can normally be reached on Monday thru Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KA
04/01/2005

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100